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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,091	03/15/2004	Roger V. Maes	7216-002US	4052
7590	11/15/2005		EXAMINER	
Jacques M. Dulin, Esq. Innovation Law Group, Ltd. 237 N. Sequim Avenue Sequim, WA 98382			ALIE, GHASSEM	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/1/05

Office Action Summary	Application No. 10/802,091	Applicant(s) MAES, ROGER V.	
	Examiner Ghassem Alie	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/08/04-07/07/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 1-8) on 10/25/05 is acknowledged. The traversal is on the ground(s) that that the invention in Groups II should be classified with the invention in Group I and therefore there will be no different search for each Group is not persuasive. Firstly, the remarks fail to respond to the reasons for distinctness of the invention in Groups I and II, as set forth in the restriction requirement. Secondly, a set of method claims cannot be classified in a same subclass as a set of apparatus claims. Further, method subclass searches are not necessary for the apparatus. In sum, it would be a serious burden on the Examiner to search both inventions in a single application. The requirement is still deemed proper and is therefore made FINAL.
2. Claims 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "60" on page 8, line 9 and "70" and "72" on page 9, lines 7-10.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "142" in Figs. 7 and 8.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

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drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 6, "the pipe to be cut" lacks antecedent basis. See claim 6, line 11.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiotani et al. (5,146,826), hereinafter Shiotani. Regarding claim 1, Shiotani teaches a portable vise and saw combination. The base 1 and the clamps 18 and 21 that are attached to the base 1 define the vise. Shiotani teaches a vise having a base 1 having three sets of engaging surfaces. The

base 1 includes three engaging surfaces for clamps 18 and 21. Shiotani also teaches a plurality of clamps 18, 21, one clamp positioned over each set of engaging surfaces. Shiotani also teaches a saw assembly 13 including a saw 3 and means 12 for mounting the saw to the base 1. It should be noted that the base includes turntable 2 and the hinge 12 mounted to the base by engaging surface and clamp 21. Shiotani also teaches that the means for mounting being attached to the base by one of clamps 18, 21 and one set of engaging surface. See Figs. 1-4 and col. 4, liners 54-68 and col. 5, lines 1-52.

Regarding claim 2, Shiotani teaches everything noted above including that the mounting device 2, 12 includes a base blade. The rotating plate 2 is rotatably mounted on a bottom plate, as shown in Fig. 5. The bottom plate is defined as the base plate of the mounting device 2, 12. Shiotani also teaches that means for rotating includes an index plate 2 mounted over the base plate and is rotatable with respect to the base plate. Shiotani also teaches that the means for rotating 2 further includes a positioning handle selectively engageable with the index plate to enable a user to select a specific angle at which the workpiece is to be cut.

Regarding claim 3-5, Shiotani teaches a portable vise and saw combination including a vise having a body 1 and a plurality of clamps 18 mounted to the body 1. Shiotani also teaches a saw 13 and a mounting device 2, 12 interconnecting the saw to the vise. Shiotani also teaches that the mounting device has a first end attached to the vice. It should be noted that one end of the turntable 2 is attached to the body 1 of the vise. Shiotani also teaches that the mounting device 2, 12 further includes means for rotating the saw to selectively position

the saw 13 with a workpiece mounted in one of the clamps 18. See Figs. 1-4 and col. 4, liners 54-68 and col. 5, lines 1-52.

Regarding claim 4, Shiotani teaches everything noted above including that the means for rotating further includes means for selecting a specific angle at which the workpiece is to be cut.

Regarding claim 5, Shiotani teaches everything noted above including that the mounting device 2, 12 includes a base blade. The rotating plate 2 is rotatably mounted on a bottom plate, as shown in Fig. 5. The bottom plate is defined as the base plate of the mounting device 2, 12. Shiotani also teaches that means for rotating includes an index plate 2 mounted over the base plate and is rotatable with respect to the base plate. Shiotani also teaches that the means for rotating 2 further includes a positioning handle selectively engageable with the index plate to enable a user to select a specific angle at which the workpiece is to be cut.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Stocker (3,645,307). Stocker teaches a portable vise and saw combination 10 including a vise 11, a base 20, 21 having three sets of engaging surfaces. The engaging surfaces are defined by the inner surface of the aluminum angle 20 at two locations where the C-clamps 22 are located and the upper surface of the horizontal flange that is engaged with the clamp 54. It should be noted that the bolt is defined as a clamp that clamps the index plate 35 to the engaging surface of the flange 27. Stocker also teaches a plurality of clamps 22, 54, one clamp positioned over each set of engaging surfaces. Stocker also teaches a saw assembly 16 including a saw and means for mounting the saw to the base 20, 21. Stocker also teaches

that the means for mounting is attached to the base by one of the clamps 54 and one set of engaging surfaces. See Figs. 1-4 and col. 1, lines 61-75 and col. 2, lines 1-38 in Stacker.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6-8, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiotani in view of Small (2,747,625). Regarding claim 6, Shiotani teaches a portable vise and saw combination including a vise having a body 1 and a plurality of clamps 18 mounted to the body 1. Shiotani also teaches a saw 13 and a mounting device 2, 12 interconnecting the saw to the vise. Shiotani also teaches that the mounting device has a first end attached to the vise. It should be noted that one end of the turntable 2 is attached to the body 1 of the vise. Shiotani also teaches that the mounting device 2, 12 further includes means for rotating the saw to selectively position the saw 13 with a workpiece mounted in one of the clamps 18. See Figs. 1-4 and col. 4, lines 54-68 and col. 5, lines 1-52. Shiotani does not teach a measuring device connected to the vise to measure a length of the workpiece. Shiotani also does not teach that the measuring device includes a measuring element extending substantially parallel to the workpiece and means for selectively adjusting the length of the measuring element to accommodate the length of the workpiece or a pipe. However, Small teaches a measuring device 16 connected to vise 33, 35 to measure a length

of a workpiece 20. Small also teaches that the measuring device includes a measuring element 28 extending substantially parallel to the workpiece 20 and means 26 for selectively adjusting the length of the measuring element to accommodate the length of the workpiece 20. See Figs. 1-4 and col. 1, lines 34-70 in Small. It would have been obvious to a person of ordinary skill in the art to provide Shiotani's cutting device with the measuring device, as taught by Small, in order to measure the length of the workpiece before is cut.

Regarding claim 7, Shiotani, as modified by Small, teaches that the measuring device includes a measuring stop 21 positioned at a distal end of the measuring element and engageable with an end of the workpiece 20 to be cut. See Figs. 1-4 and col. 1, lines 34-70 in Small.

Regarding claim 8, Shiotani teaches everything noted above including that the mounting device 2, 12 includes a base blade. The rotating plate 2 is rotatably mounted on a bottom plate, as shown in Fig. 5. The bottom plate is defined as the base plate of the mounting device 2, 12. Shiotani also teaches that means for rotating includes an index plate 2 mounted over the base plate and is rotatable with respect to the base plate. Shiotani also teaches that the means for rotating 2 further includes a positioning handle selectively engageable with the index plate to enable a user to select a specific angle at which the workpiece is to be cut.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suska (4,607,829), Schneider (4,071,061), Breese (3,883,128), DeCarolis (4,377,959),

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Golasowaki (2,778,393), Grabb (5,950,998), Huray (4,592,541), Ferreras (5,107,594), Carter (6,205,897), Chen (6,829,972), Clifton (5,197,365), Dunn (5,239,905), Bergler (4,537,105), Lindheim (2,876,808), and Markropoulos (2003/0233925) teach a portable vise and saw combination.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501.

The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (too-free).



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